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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,339	08/14/2001	Tokuju Oikawa	2870-0171P	6675

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EXAMINER

CHEA, THORL

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 08/12/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-14

Office Action Summary	Application No. 09/928,339	Applicant(s) OIKAWA, TOKUJU	
	Examiner Thorl Chea	Art Unit 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Specification

1. The application is objected to because of alterations which have not been initialed and/or dated as is required by 37 CFR 1.52(c). A properly executed oath or declaration which complies with 37 CFR 1.67(a) and identifies the application by application number and filing date is required. The deletion of the samples in Table 1, on page 106 fails to fulfill the above requirement.
2. This objection is maintained since for failing to enclose the part of document that has been amended therewith the supplemental combined Declaration and Power of attorney filed on June 13, 2003.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1, 9 –14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either JP 2000-10233 (equivalent to US Patent No. 6,165,707, issued to Hirano et al) or Inoue et al ('022).

The composition of the claimed material that meet the condition (II) of the claimed invention is disclosed in Hirano Examples 1-2 in columns 83-84 wherein the material contains nucleating agents 1, 2 or 3 in column 83 and the compound F in column 84. Note also the compound in columns 6-7, 11-16 and the nucleating agent in column 19 and Inoue et al in column 44, nucleating agent H-1 and compound G in column 45. Hirano and Inoue are silent with respect to the surface pH. However, since the composition of the material is the same or similar, it is asserted that this pH is inherent to the material of Hirano et al and Inoue , and in the absence of showing otherwise, it is asserted that the invention as claimed is either anticipated by or found obvious over Hirano et al.

6. Claims 1, 4-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent NO. 112072 (JP'072).

The photothermographic material of claim 1 is taught in the abstract of the JP'072, which contains nucleating agent and the compound of formula (A) of the claimed invention. Accordingly, the claimed invention lacks novelty.

7. Claims 1-16, 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent NO. 112072 (JP'072). The JP'072 discloses a photothermographic material that meet condition (II) claimed in the present claimed invention. On page 13 of the translation, it is disclosed that the use of ammonia to

adjust the pH film of 5.5 or less. JP'072 does not disclose the amount of NH^+ of 0.06 mmol/m² or less. However, this ammonium ion can be produced by the interaction of ammonia with water in aqueous coating solution. Accordingly, it would have been obvious to use the ammonia to adjust the pH film of 5.5 or less to provide a material of the claimed invention. The film pH of the claimed invention presented in claim 14-15 is 6.0 or less, therefore, the amount of ammonium ion in the film are same or similar.

8. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent NO. 112072 (JP'072) as applied to claims 1-16, 18-20 above, and further in view of Ito et al. Ito et al in column 82 lines 16-30 discloses phosphorus oxide-derive compound as contrast enhancer for a photothermographic material. it would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the phosphorus oxide-derive compound taught in Ito et al as contrast enhancer for the material of JP'072, and thereby provide a material as claimed.

Response to Arguments

9. Applicant's arguments filed June 13, 2003 have been fully considered but they are not persuasive. The applicants argue that the Declaration under 37 CFR 1.132 shows that the ammonium ion containing in the LACSTAR binder is an amount of 650 ppm (650 $\mu\text{g/g}$), and the amount of ammonium ion containing in the material of Hirano et al ('707) or Inoue et al ('022) is 0.25 mmol/m². Therefore, the amount of ammonium ion containing in the material of Hirano and Inoue is outside the scope required by condition I.

The argument is not persuasive. The Declaration is related to the amount of ammonium ion in the LACSTAR binder, but fails to state whether the amount of ammonium ion in all the emulsion layers is 0.25 mmol/m^2 . The amount of 0.25 mmol/m^2 is based on the Counsels' assertion, and Counsel's arguments cannot take the place of evidence. In re Greenfield, 571 F. 2d 1185, 197 USPQ 227 (CCPA 1978). Therefore, the Declaration fails to overcome the rejection under 35 USC 102 set forth in the office action of record.

It is also the Examiner's position that the claimed invention the claimed invention, if not anticipated by the applied prior art of record, at least found prima facie obvious to the worker of ordinary skill in the art since the applied prior art of record such as Inoue in column 38, lines 54-65 discloses the use of alkalis for film surface pH adjustment (pH 5.0 to 7.0), preferably hydroxides of alkali metals and alkaline earth metal. The JP'072 on page 13 of the translation in paragraph [0098] to [0101] discloses the volatile base such as ammonia and the nonvolatile acid such as an organic acid expressed with the formula (A) to adjust the surface pH of 5.5 or less. The worker of ordinary skill in the art would have use an acid or a base to adjust the surface pH of the photothermographic material such as suggested therein to provide the claimed material.

The argument with respect to the excellent effect is not persuasive since it is based on the applicants'assertion. Counsel's arguments cannot take the place of evidence. In re Greenfield, 571 F. 2d 1185, 197 USPQ 227 (CCPA 1978). The Declaration under 37 CFR 1.132 submitted on November 22, 2002 is irrelevant to the material of the prior art of record. The Declaration provides no comparative results between the claimed

material and that of the applied prior art of record. Also, the results in Table 1 of the specification disclosure is unclear whether the surface pH or the type of pH modifiers that would affect the results shown therein. The material claimed in claims 14-15 has surface pH within the scope taught in the prior art of record, and it would have been obvious to the one of ordinary skill in the art to adjust the pH accordingly therein.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (703)308-3498. The examiner can normally be reached on M-F (9:30 - 6:00).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C Baxter can be reached on (703)308-2303. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703)872-9301 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

tchea 
July 30, 2003


Thorl Chea
Primary Examiner
Art Unit 1752